

## REMARKS

### **I. Summary of Office Action**

Claims 1-13 are now pending in the application.

The Examiner rejected claims 1-13 under 35 U.S.C. § 102(b) as being anticipated by Lawler U.S. Patent No. 5,758,259 (hereinafter "Lawler").

In addition, the Examiner rejected claims 10-13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention.

### **II. Summary of Personal Interview**

On November 17, 2005, the Examiner, David Lowry (Registration No. 38,583), Jeremy Rosenberg (Vice President of Visible World, the assignee), and the undersigned conducted an interview at the United States Patent and Trademark Office on the merits of the above-identified patent application. Applicants and the undersigned wish to thank the Examiner for the courtesies extended during the interview.

The undersigned has reviewed the Examiner's remarks in the Interview Summary mailed on November April 6, 2005. Applicants acknowledge that, during the November 17, 2005 Interview, the undersigned (along with David Lowry and Jeremy Rosenberg) discussed with the Examiner the patentability of independent claims 1, 10, and 13 with respect to Lawler. Applicants provided a demonstration of the Visible World message assembly system which utilizes subject matter of the above-identified patent application.

The Examiner stated that the undersigned should set forth the arguments made during the interview in written form and that they would be considered. Accordingly, applicants have incorporated the concepts discussed in the interview in the Remarks below.

### **II. Summary of Applicants' Reply**

Applicants have amended independent claims 1, 10, and 13 in order to particularly point out and distinctly claim the subject matter which applicants regard as their invention. Applicants have also cancelled dependent claim 2.

The Examiner's rejections of the claims are respectfully traversed.

Reconsideration of this application is respectfully requested.

### **III. The Rejection of Claims 10-13 Under 35 U.S.C. § 112**

The Examiner rejected claims 10-13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. In particular, the Examiner contends that the term "said message" lacks proper antecedent basis. Claims 10 and 13 are herein amended to recite "said message template," thereby correcting the lack of antecedent basis. Applicants are not of the opinion that the amendments to claims 10 and 13 are narrowing amendments. Applicants respectfully submit that claims 10 and 13 satisfy the requirements under 35 U.S.C. § 112, second paragraph. Accordingly, in light of the amendments to claims 10 and 13, applicants respectfully request that the Examiner withdraw the rejection of these claims, and claims 11 and 12 which depend therefrom, under 35 U.S.C. § 112, second paragraph.

### **IV. The Rejection of Independent Claims 1, 10 and 13 Under 35 U.S.C. § 102(b)**

The Examiner rejected each of pending independent claims 1, 10, and 13 under 35 U.S.C. § 102(b) as being unpatentable over Lawler. The Examiner's rejection of these claims under this section is respectfully traversed.

Applicants respectfully submit that, contrary to the Examiner's contention, each of independent claims 1, 10, and 13 is allowable for at least the reasons set forth below.

#### **A. Applicants' Independent Claims are Allowable Over Lawler**

Applicants' independent claim 1 relates to a system for dynamically constructing a non-interactive personalized message to be viewed by an intended audience. As defined by independent claim 1, this system includes:

a message campaign, including:

a message template, defining a framework for constructing said personalized message, said message template comprising a plurality of media segment slots constituting said personalized message, said media segment slots including video segment slots and audio segment slots, wherein at least one video segment slot overlaps at least one audio segment slot; and

a plurality of media segments including video segments and audio segments, each video segment selectable for insertion into at least one of said video segment slots of said message template, wherein several of said video segments are selectable for a same one of said video segment slots of said message template, and wherein each audio segment is selectable for insertion into at least one of said audio segment slots of said message template;

a plurality of expert rules; and

a message assembly component, responsive to user profile data of said intended audience, and configured to apply said plurality of expert rules to said user profile data in order to select appropriate media segments for each of said media segment slots of said message template, in order to assemble said personalized message for said intended audience, said assembly performed without interaction by said intended audience.

Lawler, on the other hand, discusses methods and systems for providing viewers with “a programming guide that is automatically personalized based on the viewing history of the viewer.” (*See, e.g.*, Lawler, column 2, lines 30-33.) More particularly, as explained in column 4, lines 43-57 and FIGS. 3A and 3B, in Lawler, an on-screen, interactive program selection guide that displays information about future broadcast programs is provided, where “preferred programming may be selected according to one or more different criteria.”

Applicants respectfully submit that, contrary to the Examiner’s contention, Lawler does not show or suggest the system defined by independent claim 1 for at least the reasons set forth below.

**(i) Lawler Does Not Show or Suggest a Message Template**

As recited above, applicants’ claim 1 requires “a message template, . . . said message template comprising a plurality of media segment slots constituting said personalized message, said media segment slots including video segment slots and audio segment slots, wherein at least one video segment slot overlaps at least one audio segment slot.” As explained in applicants’ specification, “[t]he narrative framework for the final personalized message is a story as defined by a message campaign. The message campaign includes a message template and a collection of media segments.” The media segments (e.g., audio, video, background, animation, graphs, voice, etc.) are selected and then assembled to produce the final personalized message at assembly time. (*See, e.g.*, Applicants’ specification, page 6, lines 8-19.)

Contrary to the Examiner's suggestion on page 4 of the Office Action, FIG. 3A of Lawler (or any other portion of Lawler) does not show or suggest "a message template" that includes video segment slots and audio segment slots. Rather, Lawler merely shows a program guide that includes program listings that may be selected according to one or more different criteria.

In addition, applicants wish to point out to the Examiner that the program guide of Lawler is presented to the viewer. Unlike Lawler, applicants' system of claim 1 uses the message template to help assemble the personalized message. It is the personalized message that is viewed by the intended audience, not the message template.

Accordingly, applicants respectfully submit that Lawler fails to show or suggest a system including, among other things, "a message template, . . . said message template comprising a plurality of media segment slots constituting said personalized message, said media segment slots including video segment slots and audio segment slots, wherein at least one video segment slot overlaps at least one audio segment slot."

**(ii) Lawler Does Not Show or Suggest a Plurality of Media Segments**

As recited above, applicants' claim 1 requires "a plurality of media segments including video segments and audio segments, each video segment selectable for insertion into at least one of said video segment slots of said message template, wherein several of said video segments are selectable for a same one of said video segment slots of said message template, and wherein each audio segment is selectable for insertion into at least one of said audio segment slots of said message template." Contrary to the Examiner's suggestion on page 4 of the Office Action, for at least the following reasons, Lawler does not show or suggest this element of applicants' claimed invention.

As explained above, Lawler does not show or suggest a message template that includes audio segment slots and video segment slots. In fact, the program guide of Lawler is not capable of including audio and video segment slots, where at least one video segment slot and at least one audio segment slot overlap. Applicants submit that FIG. 3A of Lawler has nothing to do with audio and video segment slots. Instead, FIG. 3A of Lawler shows "a program grid 86 of program tiles 88 listing titles of programming selected according to the identified criteria at the listed times." (See Lawler, col. 4, lines 55-57.) The program tiles 88 of Lawler are not video

segment slots or audio segment slots. Thus, audio segments or video segments cannot be inserted into the program tiles 88 of Lawler.

Accordingly, because Lawler fails to show or suggest any use of “video segment slots” or “audio segment slots,” applicants respectfully submit that Lawler must also fail to show or suggest a system including “a plurality of media segments including video segments and audio segments, each video segment selectable for insertion into at least one of said video segment slots of said message template, wherein several of said video segments are selectable for a same one of said video segment slots of said message template, and wherein each audio segment is selectable for insertion into at least one of said audio segment slots of said message template.”

**(iii) Lawler Does Not Show or Suggest Assembly Performed  
Without Interaction By Said Intended Audience**

As recited above, applicants’ claim 1 requires “a message assembly component, . . . said assembly component performed without interaction by said intended audience.”

In contrast to applicants’ claimed invention, Lawler does not show or suggest using any component that assembles the personalized message without interaction by the intended audience. Instead, Lawler describes that “[i]f multiple regular viewers are located (e.g., reside) at the selected viewer station 16, the viewer or viewers watching the programming each enter a personal identification number (PIN) into station controller 20 with viewer control unit 71. Station controller 20 associates each PIN with a particular viewer identifier.” (See Lawler, col. 7, lines 37-43.) In response to entering a PIN, the Lawler system identifies and retrieves “preferred programming . . . when the viewer selects or focuses upon a program tile 88 of selective programming guide 80.” (See Lawler, col. 9, lines 24-27.) In fact, nowhere in Lawler is it shown or suggested that the assembly is performed “without interaction by said intended audience,” as required by claim 1.

Accordingly, applicants respectfully submit that Lawler fails to show or suggest a system including, among other things, “a message assembly component, . . . said assembly component performed without interaction by said intended audience.”

In view of the foregoing, applicants respectfully submit that independent claim 1 is allowable over Lawler. Therefore, applicants respectfully request that the rejection of claim 1 be withdrawn by the Examiner.

Similarly, the remaining independent claims 10 and 13 are allowable for at least the same reasons. Therefore, applicants respectfully request that the rejection of independent claims 10 and 13 also be withdrawn by the Examiner.

**V. The Rejection of Dependent Claims 2-9, 11, and 12 Under 35 U.S.C. § 102(b)**

The Examiner rejected each of dependent claims 2-9, 11, and 12 under 35 U.S.C. § 102(b) as being anticipated by Lawler. Applicants respectfully traverse the Examiner's rejection.

Applicants respectfully submit that claims 2-9, 11, and 12, each of which depends from one of independent claims 1 and 10, are allowable for at least the same reasons that the independent claims are patentable as set forth above. Therefore, applicants respectfully request that the Examiner withdraw the rejections of claims 2-9, 11, and 12.

**VI. New Counsel**

Applicants note that new counsel is handling the prosecution of the above-identified patent application and other applications for assignee. Accordingly, applicants have enclosed herewith a Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address form. Please direct all further correspondence to:

Philip R. Poh  
Wilmer Cutler Pickering Hale and Dorr LLP  
399 Park Avenue  
New York, New York 10022

## CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

In addition, each of the combination of limitations recited in the claims includes additional limitations not shown or suggested by the prior art. Therefore, for these reasons as well, applicants respectfully request withdrawal of the rejection.

Further, there is no motivation shown to combine the prior art cited by the Examiner, and even if these teachings of the prior art are combined, the combination of elements of claims, when each is interpreted as a whole, is not disclosed in the Examiner's proposed combination. As the combination of elements in each of the claims is not disclosed, applicants respectfully request that the Examiner withdraw the rejections.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely applicants' best attempt at providing one or more definitions of what the applicants believe to be suitable patent protection. In addition, the present claims provide the

intended scope of protection that applicants are seeking for this application. Therefore, no estoppel should be presumed, and applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.



## AUTHORIZATION

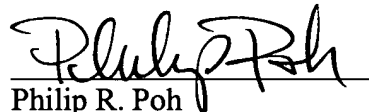
The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219.

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

WILMER CUTLER PICKERING  
HALE AND DORR LLP

Date: December 15, 2005



Philip R. Poh  
Registration No. 51,176  
Agent for Applicants

Wilmer Cutler Pickering  
Hale and Dorr LLP  
399 Park Avenue  
New York, NY 10022  
Tel. 212-230-8800  
Fax. 212-230-8888  
Customer No. 28089